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A. Wren

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/268,309 06/29/94 WREN

24M1/0301

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EXAMINER	
WEINHARDT, R	
ART UNIT	PAPER NUMBER

6

2411
DATE MAILED:

03/01/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 12/4/96 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 6-11 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. ☒ Claims 1-5 have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☒ Claims 6-11 are rejected.

5. ☐ Claims _____ are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).

12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

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1. The title of the invention is not descriptive as it is still too generic. A new title is required that is clearly indicative of the invention to which the claims are directed.

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 C.F.R. § 1.67(a) identifying this application by its Serial Number and filing date is required. See M.P.E.P. §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not make a clear claim to priority under 35 USC 120 as no related applications are listed in the section beginning "I hereby claim the benefit under Title 35, United States Code, Sect. 120 of any United States application(s) listed below..."

Also, the blank application serial number found in the original declaration has not been filled in.

3. The drawings are objected to under 37 C.F.R. § 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the database(s), the "2way" full motion video, the number of unrelated central facilities must be shown or the feature cancelled from the claim. No new matter should be entered.

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While actual correction of drawings is held in abeyance until allowance, proposed drawing corrections must be filed.

4. Claims 6-11 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 6, line 1, "the system" lacks antecedent basis. Further, the recitation of "the improvement affording the customer freedom to browse through databases of goods and services to review, with voice narration, product and service information in a self-service mode without assistance of a representative, or to bypass the self-service mode and request personal assistance" represents a desired result that is not fully supported by the recited means. Note that the recited database(s) are not specifically described as including any voice narration or video or audio. Also, the recitation of bypassing the self-service mode appears to contradict the later recitation of "enabling the customer and a representative to speak to each other during the transmission of data, audio and visual information". In addition, the recited software that appears necessary to enable reviewing of the database information is specifically recited as being located at the central facility and only being "capable of being downloaded" to the customer. Thus, the

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customer has not been positively provided with the software to perform the desired function.

Moreover in claim 6, the location of the first recited database is not clear. Is it associated with the central or customer facility? Further, the recitation of a "central computerized database facility" is not clear. Is this part of or separate from the central communications facility and is this different from the first recited database? Note that the information is recited as being accessed "at the central facility". If the central computerized database facility is different from the first recited database, it is not clear from the claim what the purpose of the first recited database would be. The recitation of "all" products and services appears to be misdescriptive as it requires information on every product and service known. The recitation of input means at the customer facility is not clear in that it is described as responding to the customer prompts. In other words, it appears that the input means itself answers these prompts.

In claim 8, it is not clear how "unrelated central facilities" make up a shopping system. In what manner are they considered "unrelated". Moreover, merely being "adapted to communicate" with other central facilities does not positively establish these facilities as part of the system.

In claim 9, the recited ability is not clear in that it is not supported with sufficient means to fulfill the function.

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In claim 10, it is not clear how the location of the facilities further defines their structure or function. In other words, it is not clear what is implied by a facility being a store or a bank.

In claim 11, it is not clear how a transaction is "finalized" since none is initiated.

Dependent claims not specifically mentioned above are rejected because by their dependence they include the language of a rejected base claim.

5. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

6. Claims 6-11 are rejected under 35 U.S.C. § 103 as being unpatentable over Dworkin in view of D'Agostino as far as the claims are definite in light of the 35 USC 112 issues raised above.

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Dworkin teaches a system for marketing products and services including a central computer facility having a database of product and service information, a customer computer terminal and communication means to allow the customer to browse through the database via prompts without the assistance of a representative. Dworkin does not specifically teach that the system includes personal assistance, however Dworkin does teach communication beyond mere self-service. Dworkin teaches means that allow the user to communicate with the management of the system via electronic mail or that this communication means can be used "for other purposes". Dworkin also teaches that certain services, such as software consulting, require communication with the service provider after a search of the database. See the abstract, figs. 1-3 and col. 10 lines 9-53. Dworkin additionally teaches that while the system is useful in purchasing computer products and services, the system is not limited to any one field.

Further, D'Agostino teaches the provision of a representative at a central facility to communicate with customers at remote locations to help in their selection of complex services via a system for providing information, completing transactions and printing documents concerning these services. As D'Agostino specifically teaches, this provides the advantage of putting the human back into high-technology, allowing more efficient provision of such services. See the abstract, summary of the invention, figs. 1, 3A-3B and 5-6 of D'Agostino. Since

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Dworkin already suggests communications beyond self-service browsing as noted above and since Dworkin provides information on products and services including complex services such as software consulting, it would have been obvious to those of ordinary skill in the art to modify the teachings of Dworkin to include a representative at the central facility as taught by D'Agostino for the efficiency and human qualities mentioned above.

With regard to D'Agostino, applicant argues that it "was not obvious to D'Agostino that some customers feel intimidated or pressured by telephone contact". However, at first, the test for obvious is not what would have been obvious to D'Agostino, but what would have been obvious to those of ordinary skill in the art. Moreover, D'Agostino, in the background of the invention, describes some people who are intimidated by ATM machines. See col. 3 lines 29+ of D'Agostino. Yet, D'Agostino is not suggesting a system to eliminate all self-service terminals by insisting on personal contact for every transaction. D'Agostino emphasizes that human interaction is desirable with complex transactions such as personal financial service transactions.

Further, if it is known that some people are intimidated by ATM machines, it must be well known that at least some people are comfortable with such machines and self-service terminals. Also, there is a proliferation of a such systems throughout a variety of arts. Thus, in view of D'Agostino's motivation for

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providing human interaction and the knowledge generally available to those of ordinary skill in the art, D'Agostino cannot be fairly characterized as rejecting self-service terminals in all cases. Therefore, as a result of the mix of products and services suggested by Dworkin, the communication facilities already built into Dworkin and the fact that Dworkin is not limited to computer products or services, it would have been obvious to those of ordinary skill in the art to provide both self-service and human interaction in the same system, as D'Agostino teaches that such interaction is helpful for complex transactions.

Finally, while Dworkin does not specifically teach the ability to transmit images, voice and data simultaneously, such hardware is well known in the art, as admitted by applicant in the specification, and includes the obvious advantages of allowing speedy, more attractive and thorough presentations of information that would have been readily recognized by those in the art. Thus, it would have been obvious to those of ordinary skill in the art to modify the teachings of Dworkin to include such hardware for its well known benefits.

7. Applicant's amendment necessitated the new grounds of rejection.

Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

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A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Weinhardt whose telephone number is (703) 305-9780. The examiner can normally be reached on Monday-Friday from 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gail Hayes, can be reached on (703) 305-9711. Facsimile transmissions to this Group may be directed to (703) 305-9564 or 9565.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3800.

February 28, 1996



ROBERT A. WEINHARDT
PRIMARY EXAMINER
GROUP 2400